

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte WILLIAM DAVID GRAHAM and JONATHAN MICHAEL VERHOFF

---

Appeal No. 2004-2038  
Application No. 09/681,778

---

ON BRIEF

---

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 6 and 15. Claim 7 has been canceled. Claims 8 through 14 and 16 through 30, the only other claims in the application, stand withdrawn from consideration by the examiner as being based upon a non-elected species of the invention; 37 CFR § 1.142(b).

Appeal No. 2004-2038  
Application No. 09/681,778

Appellants' invention pertains to an exterior panel. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears below.

As evidence of anticipation, the examiner has applied the documents listed below:

King	5,465,486	Nov. 14, 1995
Grace, Sr. et al. (Grace, Sr.)	5,946,876	Sep. 7, 1999

The following rejections are before us for review.<sup>1</sup>

Claims 1 through 6 and 15 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by King.

Claims 1 through 6 and 15 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by Grace, Sr.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper

---

<sup>1</sup> In both of the examiner's rejections set forth in the answer, claim 7 was included. However, as indicated in the brief (page 2), claim 7 was canceled by appellants (see Paper No. 6).

Appeal No. 2004-2038  
Application No. 09/681,778

No. 14), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 13 and 15).

Appellants indicate that claims 1 through 6 and 15 stand or fall together (main brief, page 3). Accordingly, we focus upon independent claim 1, infra, and the remaining claims shall stand or fall therewith.

#### OPINION

In reaching our conclusion on the anticipation issues raised in this appeal, this panel of the Board has carefully considered appellants' specification and claims, the applied teachings, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We sustain each of the examiner's anticipation rejections of claim 1. It follows that the respective anticipation rejections of dependent claims 2 through 6 and 15 are likewise sustained

Appeal No. 2004-2038  
Application No. 09/681,778

since these claims stand or fall with claim 1 as earlier indicated.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 appears below.

An exterior panel comprising:

- a) an upper portion having a width;
- b) a lower portion; and
- c) a plurality of slots extending across the width of said upper portion of said exterior panel, wherein said upper portion is fixedly securable, and wherein said plurality of slots permit relative movement of said lower portion of said exterior panel to said upper portion of said exterior panel.

At the outset, it is important to recognize, as did the examiner (answer, page 5), that claim 1 defines an exterior panel *per se*, i.e., only an external panel is broadly claimed, and not other structure; for example, nails for fixedly securing the panel when in use.

The King patent rejection

Like the examiner (answer, pages 3 and 4), we readily perceive that claim 1 is anticipated by the teaching of King, i.e., the content of broad claim 1 reads on the King disclosure.

Directing our attention to the support strip 18' of King (Fig. 13), as an example, it is quite clear to this panel of the Board that, as broad claim 1 requires, strip 18' is an exterior panel *per se* having upper and lower portions, with the upper portion being fixedly securable via holes 63, and with slots 62 permitting relative movement of the lower portion (hooked-shaped tabs 36') to the upper portion.

As was the case with the examiner (answer, pages 4 and 5), the argument of appellants (main brief, page 4, and reply brief, pages 2 and 3) fails to persuade us of error in rejecting claim 1 under 35 U.S.C. § 102(b). Appellants assert that King does not teach or suggest an upper portion fixedly securable wherein the plurality of slots permit relative movement of lower and upper portions. As explained above, broad claim 1 reads on the King disclosure. Accordingly, we are of the opinion that one skilled in this art would appreciate that the slots 62 taught by King inherently permit relative movement of a lower portion relative to an upper portion. Counsel's unsupported argument does not rebut the above determination. It is worthy of pointing out that

the circumstance that King indicates that slot 62 provides for the thermal expansion and contraction of flange portion 28', highlighted by appellants in their argument, does not detract from our inherency assessment. We conclude by noting that the matter of what the King reference suggests, as raised by appellants, supra, is not relevant to the anticipation rejection before us.

The Grace, Sr. patent rejection

We share the examiner's view (answer, page 4) that claim 1 is anticipated by the siding panel (Fig. 1) of Grace, Sr. Simply stated, the panel of Grace, Sr. includes upper slots 30 such that an upper portion of the panel is capable of being fixedly securable and a plurality of lower slots 32 that are capable of permitting relative movement of a lower portion of the panel to the upper portion thereof.

Akin to the examiner's point of view (answer, page 5), this panel of the Board is not convinced by the argument of appellants

Appeal No. 2004-2038  
Application No. 09/681,778

that the anticipation rejection based upon the Grace, Sr. patent is unsound. As we see it, appellants' argument (main brief, page 5 and reply brief, page 3) is at once not persuasive for the simple reason that it addresses possible in-use factors that are clearly distinct from the exterior panel *per se* now being claimed. Thus, contrary to appellants' point of view, we have reached the conclusion that one skilled in the art would readily comprehend that the panel of Grace, Sr. is capable of being fixedly securable and includes slots that would permit relative movement of a lower panel portion to an upper panel portion, as now broadly claimed.

In summary, this panel of the Board has sustained each of the anticipation rejections on appeal.

The decision of the examiner is affirmed.



Appeal No. 2004-2038  
Application No. 09/681,778

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

ICC:psb

Appeal No. 2004-2038  
Application No. 09/681,778

OWENS CORNING  
2790 COLUMBUS ROAD  
GRANVILLE, OH 43023